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REMARKS

Claims 1-12, and 21-28 are pending in this application.

I. Establishing anticipation.

The factual determination of anticipation requires the disclosure in a single reference of every element of the claimed invention. *Ex parte Levy*, 17 USPQ2d 1461, 1462 (PTOBPAI 1990) and the many cases cited therein. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). A reference must clearly and unequivocally disclose what is claimed "without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." *In re Arkley*, 172 USPQ524 (CCPA 1972).

Additionally, as part of the evidentiary burden on the Examiner, it is necessary for the Examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference. *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

II. Establishing a *prima facie* case of obviousness.

In order to establish a *prima facie* case of obviousness, the Examiner has the burden of showing, by reasoning or evidence, that: 1) there is some suggestion or motivation, either in the reference itself or in the knowledge available in the art, to modify that reference's teachings; 2) there is a reasonable expectation on the part of the skilled practitioner that the modification or combination has a reasonable expectation of success; and 3) the prior art reference must teach or suggest all of the claim limitations. Both the teaching or suggestion and the reasonable expectation of success must be found in the prior art and not based on an applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); see also, MPEP 2142.

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In carrying this burden, the Examiner "must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious." *Ex parte Clapp*, 227 USPQ 972, 973 (PTOBPAI 1985). A rejection based on '103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. *In re Warner*, 154 USPQ 173, 178 (CCPA 1967). The Examiner may *not*, because he may doubt that the invention is patentable, resort to speculation, unfounded assumptions, or hindsight reconstruction to supply deficiencies in his required factual basis. *Id.*

III. CHEN DOES NOT ANTICIPATE CLAIM 1.

In the Office Action, claim 1 is rejected under 35 U.S.C. §102(b) as anticipated by Chen et.al (U.S. 5,590,197)("Chen"). This rejection is traversed in view of Section I and for the following reasons.

First, Applicants wish to point out that the Examiner's general reference to essentially what equated to the entire patent does not carry the Examiner's burden of identifying with specificity, exactly where in the reference each and every element of the claimed invention is shown. *Lindemann, supra*. Contrary to the Examiner's assertion, Applicants note that Chen is silent on disclosing "an electronic selection guide page which lists a plurality of user actions (e.g., purchase a product). The only statement Chen makes in this regard is their electronic payment system and method can be used "to enable the holder of the cyber wallet to make purchases over the vast global communications network known as the Internet, with full protection of the electronic payment information from not only eavesdroppers, but also from remote merchants, without the need to verify the trustworthiness of the merchant." Col. 3, lines 38-40. Clearly, this statement is not teaching for "presenting an electronic selection guide page which lists a plurality of user actions." Additionally, no where in Chen is it disclosed or suggested that their system displays "a first electronic response page (the check out page) in response to selection of one of the plurality of actions; and the electronic response page displaying a plurality of information (e.g., description, price, etc.)." Accordingly, the Applicants request that the Examiner either identify with specificity, exactly where in Chen each and every element of the claimed invention is shown, or remove this rejection.

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Second, in the Office Action, the Examiner has clearly given no patentable weight to the use of the word "for" in the limitations of claim 1 because it is believed that the use of such a term in the claim provides no additional step. The Applicants disagree, and wish to point out that the claimed steps are explicitly limited to their application in arranging a funeral. The preamble of claim 1 recites a computerized method for arranging a funeral, and the claim limitations themselves recite and therefore are drawn and limited to arranging the funeral. See, e.g., *In re Walter*, 618 F.2d 758, 769, 205 USPQ 397, 409 (CCPA 1980) (Because none of the claimed steps were explicitly or implicitly limited to their application in seismic prospecting activities, the court held that "[a]lthough the claim preambles relate the claimed invention to the art of seismic prospecting, the claims themselves are not drawn to methods of or apparatus for seismic prospecting; they are drawn to improved mathematical methods for interpreting the results of seismic prospecting."). Cf. *In re Alappat*, 33 F.3d 1526, 1544, 31 USPQ2d 1545, 1558 (Fed. Cir. 1994) (in banc).

Additionally, the Applicants disagree that the language in claim 1 states only a purpose and intended result. The recitation of the limitations "for arranging said funeral" and "for personalizing said funeral" are functional descriptive material which limit the recited plurality of user actions and the information displayed on the electronic response page such that the computerized method performs the application of arranging the funeral, and thus these limitations have a functional interrelationship with the way in which computing processes are performed. Accordingly, the functional descriptive material "for arranging said funeral" and "for personalizing said funeral" are limitations in the claim of greater patentable weight than accorded by the Examiner, and must be considered and addressed in assessing patentability. Therefore, a rejection of the claim as a whole under § 102 and 103 is inappropriate unless, *inter alia*, the limitations of "a plurality of user actions for arranging said funeral" and an "electronic response page displaying information for personalizing said funeral" are disclosed or suggested by the prior art. See, e.g., MPEP 2106.

Third, Chen does not disclose or suggest among other things, the limitation of presenting an electronic selection guide page which lists a plurality of selectable user actions for arranging said funeral. Claim 1 also recites the limitation of displaying a first

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electronic response page in response to selection of one of said plurality of user actions; said electronic response page displaying information for personalizing said funeral.

There is clearly no teaching or suggestion in Chen that their electronic payment system and method may be used to arrange and personalize a funeral.

As Chen does not teach **each and every limitation** of claim 1, Chen cannot anticipate this claim. Withdrawal of this rejection is respectfully requested.

VI. WONG DOES NOT ANTICIPATE CLAIMS 1-12 and 21-28.

Claims 1-12 and 21-28 are rejected as being anticipated by Wong et al (US 6,115,690)("Wong"). This rejection is respectfully traversed in view of Section I and for the following reasons.

First, as with Chen, Applicants wish to point out that the Examiner's general reference to essentially what equated to the entire patent of Wong does not carry the Examiner's burden of identifying with specificity, exactly where in the reference each and every element of the claimed invention is shown. *Lindemann, supra*.

Second, for the reasons noted above in addressing Chen, the functional descriptive material "for arranging said funeral" and "for personalizing said funeral" are limitations in the claim of greater patentable weight than accorded by the Examiner, and must be considered and addressed in assessing patentability.

Accordingly, Wong does not disclose or suggest among other things, the limitation in claim 1 of presenting an electronic selection guide page which lists a plurality of selectable user actions for arranging said funeral. Claim 1 also recites the limitation of displaying a first electronic response page in response to selection of one of said plurality of user actions; said electronic response page displaying information for personalizing said funeral. There is clearly no teaching or suggestion in Wong that their integrate business-to-business web commerce and business automation system may be used to arrange and personalize a funeral.

As Wong does not teach **each and every limitation** of claim 1, Wong cannot anticipate this claim. As claim 2-12 and 21 and 28 depend from claim 1, these claims are also unanticipated by the applied art. Withdrawal of this rejection is respectfully requested.

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V. YOSHINAGA DOES NOT ANTICIPATE CLAIMS 1-12 and 21-28.

Claims 1-12 and 21-28 are rejected as being anticipated by Yoshinaga et al (JP 4 10134105 A)("Yoshinaga"). This rejection is respectfully traversed in view of Section I and for the following reasons.

For the reasons noted above in addressing Chen and Wong, the functional descriptive material "for arranging said funeral" and "for personalizing said funeral" are limitations in the claim of greater patentable weight than accorded by the Examiner, and must be considered and addressed in assessing patentability.

Accordingly, Yoshinaga does not disclose or suggest among other things, the limitation in claim 1 of presenting an electronic selection guide page which lists a plurality of selectable user actions for arranging said funeral. Claim 1 also recites the limitation of displaying a first electronic response page in response to selection of one of said plurality of user actions; said electronic response page displaying information for personalizing said funeral. Yoshinaga discloses providing a HTML document showing information on traders relating to exequy (e.g., burial), funeral and mourning services, and links to their home pages. There is clearly no teaching or suggestion in Yoshinaga that their HTML web page listing exequy (e.g., burial), funeral and mourning services may be used to arrange and personalize a funeral as required by claim 1.

As Yoshinaga does not teach **each and every limitation** of claim 1, Yoshinaga cannot anticipate this claim. As claim 2-12 and 21 and 28 depend from claim 1, these claims are also unanticipated by the applied art. Withdrawal of this rejection is respectfully requested.

VI. TORRES IS NOT A PRIOR ART REFERENCE TO CLAIMS 2-12 and 21-28.

Claims 2-12 are rejected under 35 USC 102(e) as being anticipated by Torres et al (US 2002/0004757). Claims 2-12 are rejected under 35 USC 103(a) as being unpatentable over Torres ('757). These rejections are respectfully traversed.

Enclosed with this response is a declaration under 37 CFR 1.131 (along with Exhibit A), which substantiates that the invention recited by claims 1-12 and 21-28 was reduced to practice prior to the filing date of Torres. As such, Torres is not prior art

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under §102(e), and cannot form the basis for a rejection under §103. Therefore, Applicants respectfully request withdrawal of the above noted rejections to the claims.

VII. CONCLUSION

The prior art references clearly do not anticipate, nor render obvious, the claims of the present invention as they do not teach or suggest the recited invention of the claims.

Applicants respectfully submit that the present application is in condition for allowance. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response. Otherwise, early notification of allowable subject matter is respectfully solicited.

Respectfully submitted,
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